

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Gruma Corporation

Serial No. 88863832

John M. Cone of Ferguson Braswell Fraser Kubasta PC
for Gruma Corporation.

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Before Greenbaum, Adlin and Hudis, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Gruma Corporation seeks a Principal Register registration for the mark MISSION PLANITAS, in standard characters (PLANITAS disclaimed), for “tostadas” in International Class 30.¹ According to the application, “[t]he English translation of PLANITAS in the mark is FLATS.” The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that

¹ Application Serial No. 88863832 was filed on April 8, 2020 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based on an alleged intent to use the mark in commerce.

Applicant's mark so resembles the previously registered mark PLANITAS, in standard characters² and in the form shown below



for “tortillas,” in International Class 30, that it is likely to cause confusion, mistake or deception. The cited Principal Register registrations are commonly-owned and, like the involved application, indicate that “[t]he English translation of ‘PLANITAS’ in the mark is ‘Flats’.” After the refusal became final, Applicant appealed and filed a request for reconsideration that was denied. The appeal is fully briefed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We must consider each *DuPont* factor about which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d

² Registration No. 5533742, issued on August 7, 2018. In addition to “tortillas”, this registration also identifies “bread” in International Class 30.

³ Registration No. 5421868, issued on March 13, 2018. This registration includes this description of the mark: “The mark consists of the stylized red wording ‘PLANITAS’, with a layer of yellow shading around the letters, which itself features another layer of blue shading. Around the entire literal element is a single-line blue outline which tracks the letters, and features white space between the letters and the outlining. The letter ‘I’ is dotted with a red star that features yellow and white shading, and blue outlining. The white background is for background purposes only and is not claimed as a feature of the mark.”

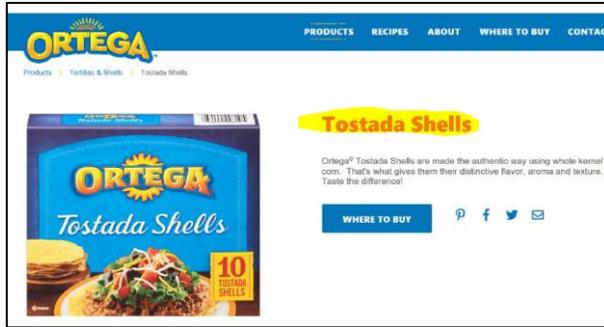
1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

We focus here on Registrant’s standard character mark PLANITAS. If we find confusion likely between Registrant’s standard character mark and Applicant’s involved mark, we need not consider the likelihood of confusion between Applicant’s mark and Registrant’s design mark. On the other hand, if we find no likelihood of confusion between Registrant’s standard character mark and Applicant’s mark, we would not find confusion likely between Applicant’s mark and Registrant’s design mark. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Goods, Their Channels of Trade and Classes of Consumers

The Examining Attorney has established that tortillas are closely related to tostadas, because a number of third parties use the same marks on tortillas as they do on tostadas, as shown below:





May 26, 2020 Office Action TSDR 10, 12, 14, 16, 18;⁴ December 10, 2020 Office Action TSDR 10, 12 (emphasis added). The Examining Attorney also submitted equivalent examples from three additional third parties. December 10, 2020 Office Action TSDR 14, 16, 18, 20, 22, 24. This third-party use evidence establishes a close relationship

⁴ Citations to the application file are to the USPTO's Trademark Status & Document Retrieval ("TSDR") online database, by page number, in the downloadable .pdf format.

between Applicant's and Registrant's goods. See *In re Detroit Athletic*, 128 USPQ2d at 1050 (crediting relatedness evidence showing that third parties use the same mark for the goods and services at issue because "[t]his evidence suggests that consumers are accustomed to seeing a single mark associated with a source that sells both"); *Hewlett-Packard Co.*, 62 USPQ2d at 1004 (evidence that "a single company sells the goods and services of both parties, if presented, is relevant to a relatedness analysis").

Furthermore, there is evidence that the public perceives tostadas and tortillas as related, and perhaps even identical. In the MEXICAN PLEASE article "What is a Tostada?," the initial, most general answer to the article's title question is "Just think fried corn tortilla and you're on the right track!" December 10, 2020 Office Action TSDR 26-27. Similarly, the EPICURIOUS article "How to Make Tostadas from Stale Store-Bought Tortillas" reveals a close relationship between the goods in its title. *Id.* at 37. These publications also tend to suggest that the goods may be effectively identical.

Finally, the Examining Attorney introduced 10 use-based third-party registrations showing that the same marks are registered in connection with both tostadas and tortillas. *Id.* at 45-73. "Third-party registrations which cover a number of differing goods and/or services, and which are based on use in commerce, although not evidence that the marks shown therein are in use on a commercial scale or that the public is familiar with them, may nevertheless have some probative value to the extent that they may serve to suggest that such goods or services are of a type which may emanate from a single source." *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467,

1470 n.6 (TTAB 1998). This evidence supports and bolsters the Examining Attorney's third-party use and media evidence.

In short, there is no question that the goods are very closely related, and perhaps even identical. Moreover, the third-party use evidence also establishes that the channels of trade and classes of consumers overlap, because tostadas and tortillas are offered on the same grocery and Mexican food producer websites to the same consumers, specifically, purchasers of Mexican food. *See also Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, 719 F.3d 1367, 107 USPQ2d 1167, 1173 (Fed. Cir. 2013) (goods identified without trade channel limitations presumed to move in all normal channels of trade for those goods). Applicant concedes, and is clearly correct, that these factors “support a finding of likelihood of confusion.” 7 TTABVUE 6.⁵

In fact, these factors not only weigh heavily in support of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010). The crux of this case is the similarity or dissimilarity of the marks.

B. The Marks

The cited registration is for a word mark, PLANITAS, and the involved application combines that word mark with Applicant's house mark, MISSION, to create

⁵ Citations to the appeal record are to TTABVUE, the Board's online docketing system. The number preceding TTABVUE corresponds to the docket entry number, and any numbers following TTABVUE refer to the page(s) of the docket entry where the cited materials appear.

MISSION PLANITAS. As the cases cited below illustrate, this is not an uncommon situation.

1. Adding House Marks to Registered Terms – General Principles

Oftentimes, the addition of a house mark to a registered mark is found insufficient to avoid confusion, and is sometimes even found to be an “aggravation, and not a justification....” *Menendez v. Holt*, 128 U.S. 514, 521 (1888). See also *In re Fiesta Palms LLC*, 85 USPQ2d 1360, 1367 (TTAB 2007) (affirming refusal to register CLUB PALMS MVP based on prior registration of MVP, finding consumers “likely to believe that the CLUB PALMS MVP casino services is simply the now identified source of the previously anonymous MVP casino services”); *In re Pierce Foods Corp.*, 230 USPQ 307, 309 (TTAB 1986) (in dicta, stating that even if Applicant’s proposed amendment to its drawing was accepted, “[a]pplicant’s institutional purchasers, aware of registrant’s CHICKEN BAKE coating mix, may well believe that applicant’s PIERCE CHIK’N BAKE pre-seasoned chicken is a product produced under license from registrant or otherwise sponsored or produced by registrant.”); *Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co.*, 216 USPQ 168 (TTAB 1982) (finding likelihood of confusion between SKIN SAVERS for face and throat lotion and MENNEN SKIN SAVER for cosmetic and toilet preparations, namely, hand and body lotion); *In re C.F. Hathaway Co.*, 190 USPQ 343 (TTAB 1976) (affirming refusal to register HATHAWAY GOLF CLASSIC based on registration of GOLF CLASSIC).⁶

⁶ In analogous circumstances, we affirmed a refusal to register VANTAGE TITAN based on a registration for TITAN, stating: “Applicant has taken registrant’s mark and added its ‘product mark’ to it. It is not clear why the addition of the word VANTAGE would avoid

There are other times, however, where adding a house mark to a registered mark is sufficient to avoid confusion. These cases typically involve “highly suggestive” shared terms. For example, in *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005), we found no likelihood of confusion between NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS, both for women’s clothing, because evidence established that the shared, registered term ESSENTIALS is “highly suggestive.” *See also* TMEP §1207.01(b)(iii) (July 2021) (“Additions or deletions to marks may be sufficient to avoid a likelihood of confusion if ... the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.”).

In *Knight Textile*, we found ESSENTIALS to be “highly suggestive” of women’s clothing based in part on a dictionary definition, pointing out that the term “connotes that the clothing items sold under the marks are basic and indispensable components of, or ‘essentials’ of, one’s wardrobe.” *Id.* at 1316. This finding was supported by 23 third-party registrations (registered to 21 different owners) for marks which include ESSENTIALS for clothing, “at least two” of which “are comprised of the word ESSENTIALS coupled with apparent house marks.” *Id.* at 1316-17 & n.7.

Thus, we turn to the cited mark’s distinctiveness.

confusion. It is more likely to be considered another product from the previously anonymous source of TITAN medical diagnostic apparatus, namely, medical ultrasound devices.” *In re Toshiba Medical Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009). *See also*, *Stone Lion Capital Partners, L.P. v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (finding STONE LION CAPITAL confusingly similar to LION and LION CAPITAL).

2. How Distinctive is PLANITAS?

Applicant has argued, throughout prosecution and on appeal, that the marks' shared term PLANITAS is "highly descriptive if not generic" or "descriptive/generic" for tostadas and tortillas. *See, e.g.* September 30, 2020 Office Action response TSDR 2-3 and 7 TTABVUE 9-14. However, as the Examining Attorney has pointed out throughout prosecution and on appeal, the cited registration is presumed valid and its inherent distinctiveness "cannot be challenged in an *ex parte* proceeding." 9 TTABVUE 7 (quoting *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1517 (TTAB 2016) and citing 15 U.S.C. § 1057(b)). *See also In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1535 (Fed. Cir. 1997).⁷

Perhaps in recognition of this well-settled Federal Circuit and Board authority, Applicant alternatively argues that the shared term PLANITAS is highly suggestive, and thus that the addition of Applicant's house mark to form MISSION PLANITAS is sufficient to avoid confusion, even though the marks are used on closely related goods. 7 TTABVUE 13-14. In other words, Applicant argues that this case is analogous to *Knight Textile*.

More specifically, Applicant argues that according to the translation statements in the involved application and cited registrations, PLANITAS means "flats" in Spanish, and as such is highly suggestive of "flat" breads, such as tortillas, tostadas, naan, pitas and other types of "flat" bread, under the doctrine of foreign equivalents.

⁷ For this reason, we question why Applicant did not petition to cancel the cited registrations. In such an *inter partes* proceeding, Applicant would be entitled to allege that PLANITAS is descriptive or generic.

Under the doctrine of foreign equivalents, foreign words from common languages are translated into English to determine similarity of connotation with English word marks. *See Palm Bay Import, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The doctrine is applied when it is likely that “the ordinary American purchaser would ‘stop and translate [the term] into its English equivalent.’” *Palm Bay*, supra at 1696, quoting *In re Pan Tex Hotel Corp.*, 190 USPQ 109, 110 (TTAB 1976).

In re Thomas, 79 USPQ2d 1021, 1024 (TTAB 2006).

As we have repeatedly held, Spanish is a “common language” in the United States, and we have routinely applied the doctrine of foreign equivalents to Spanish language marks. *In re Aquamar, Inc.*, 115 USPQ2d 1122, 1127 (TTAB 2015); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1648 (TTAB 2008) (“there is no question that Spanish is a common, modern language”); *In re Perez*, 21 USPQ2d 1075 (TTAB 1991); *In re American Safety Razor Co.*, 2 USPQ2d 1459 (TTAB 1987); *In re Hub Distributing, Inc.*, 218 USPQ 284 (TTAB 1983); *Rosenblum v. George Willsher & Co.*, 161 USPQ 492 (TTAB 1969). We also take judicial notice of the August 2013 United States Census Bureau’s “Language Use in the United States: 2011” report, which indicates that after English, Spanish is the most commonly spoken language in the United States, and that over 12% of the United States population speaks Spanish.⁸

As for whether ordinary purchasers of tortillas and tostadas would stop and translate the cited mark PLANITAS into English, this record is unclear. In fact, the

⁸ www2.census.gov/library/publications/2013/acs/acs-22/acs-22.pdf. The Board may take judicial notice of census data. *In re Tokutake Indus. Co.*, 87 USPQ2d 1697, 1700 n.1 (TTAB 2008).

involved application is based on an intent to use rather than actual use, and there is no evidence showing whether or how Applicant has used the MISSION PLANITAS mark. Thus, there is no way for us to assess how consumers would encounter the mark, because we have no specimens or examples of use, and we do not know exactly how or to whom Applicant will market the goods.

In the past we have found that consumers are likely to “stop and translate” a mark or term when, for example, the record reveals that the goods are specifically targeted to Spanish speakers or sold in bilingual packaging. *Cf. In re Aquamar*, 115 USPQ2d at 1127 (finding that consumers would likely stop and translate Spanish term into English because goods in question were “designed to truly target the US Hispanic market with authentic bilingual packaging”) and *In re American Safety Razor*, 2 USPQ2d at 1460 (“ ... applicant markets and sells its soap ... to Spanish-speaking purchasers. We believe that those bilingual purchasers familiar with registrant’s ‘GOOD MORNING’ and design shaving cream would, upon encountering applicant’s ‘BUENOS DIAS’ soap sold with Spanish-language phrases appearing on the container and with the name of the goods appearing in Spanish, be likely to translate ‘BUENOS DIAS’ into its ‘GOOD MORNING’ English equivalent and mistakenly believe that the ‘BUENOS DIAS’ product was a product emanating from registrant and marketed to the Spanish speaking public.”). The absence of similar evidence in this record leaves us unable to make an analogous finding here.⁹

⁹ Establishing that consumers would “stop and translate” and that the doctrine of foreign equivalents should apply may very well have been easier in an *inter partes* proceeding.

Therefore, we must consider the meaning and distinctiveness of “PLANITAS” as opposed to “flats,” its apparent English translation. The record is quite thin on this point, however. Indeed, the Examining Attorney specifically pointed out during prosecution that Applicant did “not provide evidence that the term ‘PLANITAS’ is commonly used in the industry to describe” the goods, nor did it provide “any translation evidence that shows the wording ‘PLANITAS’ directly translates to the English wording ‘flats.’” December 10, 2020 Office Action TSDR 4. At the same time, the Examining Attorney introduced “negative translation evidence show[ing] that the wording ‘PLANITAS’ has no direct translation in English.” *Id.* at 4, 7. Nevertheless, Applicant did not provide translation or dictionary evidence in response, instead merely arguing, in slightly more detail than before, that “[t]he Spanish word PLANO is an adjective meaning ‘flat.’ PLANITAS is the diminutive of PLANO.” June 9, 2021 Request for Reconsideration TSDR 1.¹⁰

While we accept that one meaning of “planitas” is “flats” based on the essentially identical translation statements in the involved application and cited registrations, we do not have an authoritative or full assessment of the word’s potential connotations or typical uses, including any subtleties in how it is used or perceived in modern Spanish. Thus, while the translation statements are enough for us to find

¹⁰ With its Appeal Brief, Applicant submitted for the first time a document from “translate.com” which indicates that the English translation of “planitas” is “flats.” 7 TTABVUE 19. This submission was too late, however, because evidence must be submitted prior to appeal. Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d). In fact, the Examining Attorney has not had the opportunity to question or challenge this translation, or introduce contradictory evidence, and the late submission has therefore not been considered.

that the term is certainly suggestive of tortillas and tostadas, we cannot determine how suggestive, a critical inquiry under *Knight Textile* and analogous cases.¹¹ As a result, we find that this case is more like *In re Fiesta Palms, Key West Fragrance* and similar cases than *Knight Textile*, because Applicant has not shown PLANITAS to be “highly” suggestive for tortillas and tostadas, the goods in question here.

¹¹ Even if we applied the doctrine of foreign equivalents, and as a result considered the suggestiveness of “flats” as opposed to “planitas,” the result would be the same. Specifically, while the record shows through third party and media use of “flats” that the term is descriptive of flatbread, September 30, 2020 Office Action response TSDR 52-64, flatbread is not the same thing as tortillas or tostadas, and the record does not show common, or even any, use of “flats” in connection with tostadas or tortillas specifically.

Similarly, Applicant has shown that the USPTO has fairly consistently treated the term “flats” as merely descriptive of flat bread products, including “rolls,” “unleavened bread,” “crackers,” “wheat based snack foods” and “flatbread sandwich.” *Id.* at 78, 126, 127, 130, 237, 241. But there is no evidence that the USPTO has treated the term as descriptive of tortillas and tostadas. While Applicant introduced evidence from an application file showing a requirement to disclaim FLATS for “taco shells,” applications, as opposed to issued registrations, have “no probative value other than as evidence that the application was filed.” *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010) (quoting *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002)). Here, the record does not show whether this mark was ultimately registered, or even that the disclaimer requirement was maintained until registration. In any event, even if taco shells are essentially the same as tostadas or tortillas, a single disclaimer requirement in one pending application is a far cry from establishing a consistent Office practice.

Finally, Applicant’s claim in its Appeal Brief that there are seven additional, analogous examples of the Office treating “flats” as merely descriptive of flatbread is not persuasive for the reasons discussed above. Moreover, Applicant did not introduce these alleged applications, registrations or relevant Office Actions into the record. 7 TTABVUE 12-13. Applicant’s mere listing of these allegedly similar marks and their registration or serial numbers is not enough to make them of record, and Applicant has not otherwise shown that these applications or registrations include disclaimers of “FLATS,” are registered on the Supplemental Register, include a claim of acquired distinctiveness or were refused under Section 2(e)(1). *Cf. Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012) (explaining that “[t]he Board does not take judicial notice of registrations or applications” and that the information Applicant relied on could not be gleaned from Applicant’s description of the registrations). Therefore, we have not considered these allegedly similar additional examples, which suffer the same infirmities as the registrations Applicant properly introduced into the record.

3. How Distinctive is Applicant's House Mark MISSION?

Applicant argues, and the record reveals, that in contrast to the term FLATS for flat bread products, the term MISSION is relatively strong, both conceptually and commercially. One of Applicant's registrations for the mark MISSION (for "corn tortillas, wheat flour tortillas, taco shells, tostados shells") is 40 years old. *Id.* at 18-22.¹²

Moreover, A FOOD BUSINESS NEWS article largely about Applicant's subsidiary Mission Foods entitled "A New Take on Tortillas" indicates that Applicant has been successful and that products bearing its subsidiary's MISSION house mark have enjoyed substantial sales. Specifically, between April 2018 and April 2019, Mission Foods's sales "in the hard/soft tortillas/taco kits segment" approached \$1 billion, "which accounts for more than 32% of total segment sales." *Id.* at 28-29. The MISSION brand's in-store prominence is revealed by these photos of the company's store displays:



¹² Applicant provided a list of over 50 additional MISSION registrations it claims to own for food products, the overwhelming majority of which allegedly identify tortillas, tostadas and other flat bread products. September 30, 2020 Office Action response TSDR 24-26. As explained above, however, the mere list is not sufficient to make these alleged registrations of record, and they have not been considered.



Id. at 40-50. This evidence establishes that MISSION is commercially strong. *See e.g. Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012) (commercial strength may be shown by “length of use of the mark, market share, brand awareness ..., and variety of goods bearing the mark”).

There is no evidence that MISSION has any meaning in connection with tortillas or other flat bread products. We therefore find that the term MISSION is arbitrary (conceptually strong) when used in connection with tostadas, and also commercially strong.

4. Comparing the Marks in Their Entireties

We compare the marks “in their entireties as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). Here, Applicant’s mark and the cited mark are

similar because they both include the suggestive term PLANITAS, and different because Applicant's mark begins with the stronger term MISSION which is absent from the cited mark. When considered in their entireties, we find that the marks are more similar than dissimilar, because here as in cases such as *In re Fiesta Palms*, consumers are "likely to believe that" MISSION is "simply the now identified source of the previously anonymous" PLANITAS tortillas. 85 USPQ2d at 1367.

In fact, because Applicant's mark incorporates PLANITAS, the entirety of Registrant's mark, the marks look and sound identical in part. While MISSION obviously distinguishes Applicant's mark from Registrant's in appearance and sound, these differences are not consequential here because of the meaning conveyed and commercial impression created by the house mark MISSION. Specifically, because MISSION is likely to be perceived as a house mark, Applicant's mark as a whole is likely to be perceived as a version of Registrant's mark which merely identifies the product's source. This consumer perception is especially likely in this case because the goods are so closely related. Consumers familiar with Registrant's PLANITAS mark and goods would naturally and understandably assume that MISSION is the company that produces both PLANITAS tortillas and MISSION PLANITAS tostadas.

II. Conclusion

The goods are quite closely related and their channels of trade and classes of consumers overlap. The marks are similar in appearance, sound, meaning and commercial impression because they share the same term PLANITAS. While we have not ignored the term MISSION in Applicant's mark, consumers will perceive

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PLANITAS as Applicant's product mark for tostadas, a term identical to Registrant's product mark for quite similar goods, tortillas. As a result, source confusion is likely.

Decision: The refusal to register Applicant's mark under Section 2(d) of the Trademark Act is affirmed.